

REMARKS

In the Office Action dated August 12, 2003, the Examiner objected to the specification and rejected pending claims 53-157. In particular, the Examiner rejected claims 57, 64, 67-72, 77, 80-86, 87-102, 104, 107, 110, 112-114, 117, 119-121, 123, 138, 143-150, 155, and 157 under 35 U.S.C. § 112, first paragraph, as containing subject matter that was not sufficiently described in the specification. Claims 127, 132, 153, and 154 were rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter of the invention. Claims 53-72, 80-97, 106-108, 112-114, 119, 121, 123, 145-152, and 155-157 were rejected under 35 U.S.C. § 102(b) as being anticipated by *Hedges et al.*, U.S. Patent No. 4,467,424. Claims 73-79, 103-105, 109-111, 115-118, 124, 127, 129, 130, 132, 134, 136, 138, 139, 141, 143, and 144 were rejected under 35 U.S.C. § 102(e) as being anticipated by *Franchi*, U.S. Patent No. 5,770,533. Under 35 U.S.C. § 103(a), claims 126, 128, 131, 133, 135, 137, 140, and 142 were rejected as being obvious over *Franchi*, and claims 120, 153, and 154 were rejected as being obvious over *Hedges et al.* in view of *Franchi*.

By this Amendment, Applicants have amended claims 57, 60, 64, 67, 72, 77, 80, 84, 87, 92-94, 98-99, 112-113, 119-120, 122-123, 127, 132, 138, 143, 145, 147, 150, 153-155, and 157, taking care not to add any new matter. Applicants have also cancelled claims 103-111 and 115-118 without prejudice or disclaimer of the subject matter recited therein.

Information Disclosure Statement

Applicants have filed two Information Disclosure Statements in this application to date. The first was filed on January 4, 2002 with a form PTO 1449 listing references filed in the parent application no. 08/877,375, now U.S. Patent No. 6,280,328, for the Examiner's consideration. In

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the Office Action, the Examiner noted that the Patent Office files no longer contain copies of all of the non-patent literature filed during prosecution of the parent application. For the Examiner's convenience, Applicants enclose herewith additional copies of the references that the Examiner indicated are missing from the Patent Office files. Applicants note, however, that one reference, "Introducing a World of Opportunities," by Bally Systems, cannot be located in Applicants' files or through searches conducted by Applicants' representatives. Therefore, Applicants respectfully request that the Examiner reexamine the parent application files in search of that reference.

A second Information Disclosure Statement was filed on October 9, 2003, after the mailing date of the Office Action. Applicants respectfully request that the Examiner consider the enclosed references together with the references cited in the October 9, 2003 Statement and return the initialed form PTO 1449 to indicate that the references have been considered.

Specification Objections

The Examiner objected to the proposed amendments to the specification on two grounds. First, the Examiner alleged that receiving game information on a per-game basis or every time a wager is received enlarges the scope of the original disclosure. Second, the Examiner alleged that some of the examples given to describe game information constitute new matter.

To resolve any confusion over terminology, Applicants have amended the specification to clarify that player activity information may be received by a central controller on a per-game basis. As described in the original disclosure of the parent application, now U.S. Patent No. 6,280,328 (hereafter, "the '328 patent"), the central control network "tracks each player activity, preferably on a per-game basis, to maintain current and comprehensive information about the

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players at any time....” (‘328 patent, col. 5, ll. 24-27.) To track player activity information, the central control network comprises an account server that stores player account information, player card information, and game information. (‘328 patent, col. 5, ll. 21-40.) Because tracking player activity information on a per-game basis is clearly described in the original disclosure, the Applicants respectfully request the consideration of the foregoing specification amendments and the withdrawal of the objections to the specification.

Section 112 Rejections

The Examiner rejected claims 57, 64, 67-72, 77, 80-86, 87-102, 104, 107, 110, 112-114, 117, 119-121, 123, 138, 143-150, 155, and 157 under 35 U.S.C. § 112, first paragraph, for two reasons. First, the Examiner alleged that transmitting game information on a per-game basis or for each wager received constitutes new matter. Second, the Examiner alleged that the phrase “game terminal number” is not supported by the specification.

By this Amendment, Applicants have amended claims 67, 80, 87, 93, 98, 112, 119, 143, 145, 147, 150, and 155 to recite transmitting player activity information on a per-game basis and/or receiving player activity information for each game for which a wager amount was received. For example, claim 67 recites a structure that includes, among other things, a game terminal including means for transmitting player activity information on a per-game basis and a central controller including means for receiving player activity information for each game for which a wager amount was received. In another example, claim 147 recites a method including the step of receiving, from a game terminal, player activity information every time a wager amount is received by the game terminal. As described in the original disclosure of the parent application,

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In one embodiment, player terminals 100 transmit real-time to account server 400 all player activity information input by the player. This information may include, for example, the player's account number, information on the game played, and the game choices selected by the player, the wager amount, the winning numbers provided by the game server 102, and a credit or debit request for crediting or debiting the player's account the wager amount... . Accordingly, central controller network 104 maintains a current and comprehensive player activity information... .

('328 patent, col. 8, ll. 53-66.) Because tracking player activity information on a per-game basis is clearly described in the original disclosure, the Applicants respectfully request the reconsideration and withdrawal of the rejections of amended claims 67, 80, 87, 93, 98, 112, 119, 143, 145, 147, 150, and 155 and the claims that depend therefrom.

Furthermore, by this Amendment Applicants have amended claims 57, 64, 77, 84, 92, 104, 107, 110, 113, 120, 123, 138, and 157 to recite a player terminal number rather than a game terminal number and amended claims 94 and 99 to remove the phrase game terminal number. A player terminal number is clearly described as a type of game information in the original disclosure. ('328 patent, col. 8, ll. 19-20.) Therefore, Applicants request the reconsideration and withdrawal of the rejections of claims 57, 64, 77, 84, 92, 94, 99, 104, 107, 110, 113, 117, 120, 123, 138, and 157.

Finally, Applicants have cancelled claim 117 without prejudice or disclaimer of the subject matter recited therein.

The Examiner rejected claims 127, 132, 153, and 154 under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter of the invention. By this Amendment, Applicants have amended claims 127 and 132 to recite a plurality of game terminals that include a means for determining a set of random numbers.

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Applicants have also amended claims 153 and 154 to address the Examiner's antecedent basis objections. In view of these amendments, Applicants request the withdrawal of the section 112 rejections of claims 127, 132, 153, and 154.

Section 102 Rejections

Claims 53-72, 80-97, 106-108, 112-114, 119, 121, 123, 145-152, and 155-157 were rejected under 35 U.S.C. § 102(b) as anticipated by *Hedges et al.*, U.S. Patent No. 4,467,424. To anticipate a claim, the reference must teach every element of the claim. M.P.E.P. § 2131.01 (8th ed. 2001, revised February 2003). Applicants respectfully submit that *Hedges et al.* fails to disclose every element of claims 53-72, 80-97, 106-108, 112-114, 119, 121, 123, 145-152, and 155-157.

For example, claim 53 recites, among other things, a game terminal including both a means for executing an application program in response to an externally-generated random number and a means for displaying the result of the game. *Hedges et al.* fails to disclose such a combination. In *Hedges et al.*, a remote croupier determines the results of a game and sends the results to a credit station. The credit station adjusts the player's account and sends the player's new account balance to the player terminal, where the new account balance is displayed. (*Hedges et al.*, col. 13, ll. 53-65.) Even if, as the Examiner alleges, the software executed by the player terminal to display the new account balance is executed in response to an externally-generated random number, the reference fails to teach a separate means for displaying the result of the game, as required by claim 53. In the Examiner's interpretation of the reference, there would be no need for a means for displaying the result of the game in addition to a means for executing an application program in response to an externally-generated random number.

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Furthermore, the player terminal of *Hedges et al.* does not even receive an externally-generated random number to which the terminal could respond. Because *Hedges et al.* does not teach every element of claim 53 and the claims that depend therefrom, Applicants respectfully request the withdrawal of the section 102 rejections of claims 53-59.

Like claim 53, claims 67 and 93 recite, among other things, a game terminal including a combination of means for executing an application program in response to an externally-generated random number and means for displaying the result of the game. For the reasons given above, *Hedges et al.* fails to disclose this combination of claim elements, as required by claims 67 and 93, and the claims that depend therefrom. Therefore, Applicants respectfully request the withdrawal of the section 102 rejections of claims 67-72 and 93-97.

Claim 60, as amended, recites a player terminal including means for determining the result of a game. *Hedges et al.* do not disclose such a structure. Instead, in the reference, the numerical results of a game are determined by a remote croupier station. (*Hedges et al.*, col. 3, ll. 7-14; col. 6, l. 67 - col. 7, l. 2.) Because *Hedges et al.* does not teach every element of amended claim 60 and the claims that depend therefrom, Applicants respectfully request the reconsideration and withdrawal of the section 102 rejections of claims 60-66.

Claims 80 and 87, as amended, recite a method including the steps of executing an application program at one of a plurality of game terminals in response to an externally-generated random number and displaying, by the one of the plurality of game terminals, the result of the game. As discussed above with respect to claim 53, *Hedges et al.* fails to disclose a game terminal that performs both of these steps as required by amended claims 80 and 87, and

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the claims that depend therefrom. Therefore, Applicants respectfully request the reconsideration and withdrawal of the section 102 rejections of claims 80-92, 151, and 152.

As amended, claims 106, 112, 119, 122, 145, and 155 recite, among other things, game terminals that execute application programs in response to an externally-generated random number display a result of a game. For the reasons given above, *Hedges et al.* fails to disclose game terminals with this combination of elements, as required by amended claims 106, 112, 119, 122, 145, and 155, and the claims that depend therefrom. Therefore, Applicants respectfully request the reconsideration and withdrawal of the section 102 rejections of claims 106-108, 112-114, 119-123, 145-150, and 155-157.

Claims 73-79, 103-105, 109-111, 115-118, 124, 127, 129, 130, 132, 134, 136, 138, 139, 141, 143, and 144 were rejected under 35 U.S.C. § 102(e) as anticipated by *Franchi*, U.S. Patent No. 5,770,533. To anticipate a claim, the reference must teach every element of the claim. M.P.E.P. § 2131.01 (8th ed. 2001, revised February 2003). By this Amendment, Applicants have canceled claims 103-111 and 115-118 without prejudice or disclaimer of the subject matter recited therein. Furthermore, Applicants respectfully submit that *Franchi* fails to disclose every element of claims 73-79, 124, 127, 129, 130, 132, 134, 136, 138, 139, 141, 143, and 144.

For example, claim 73 recites, among other things, a method including the step of receiving, at one of a plurality of game terminals, a game choice and a wager amount for a game. *Franchi* fails to disclose such a method. Instead, *Franchi* discloses a series of individual game computers, each set up to monitor one game such as blackjack or craps. (*Franchi*, col. 5, ll. 13-24.) Because each game computer monitors only a single game, there is no need for the game computer to receive a game choice. Indeed, the reference merely teaches that a player “may

place a bet and perform all options available to the player in the particular game." (*Franchi*, Abstract (emphasis added).) Because the reference fails to disclose every element of claim 73, and the claims that depend therefrom, Applicants request the withdrawal of the section 102 rejections of claims 73-79.

Like claim 73, claims 134, 139, and 143 recite a method including the step of receiving, at one of a plurality of game terminals, a game choice and a wager amount for a game. *Franchi* fails to disclose such a method for at least the reasons given above. Therefore, the reference fails to disclose every element of claims 134, 139, and 143, and the claims that depend therefrom, and Applicants request the withdrawal of the section 102 rejections of claims 134, 136, 138, 139, 141, 143, and 144.

Claims 124 and 129 recite, among other things, a gaming terminal including means for receiving a game choice for a game from a player. As discussed above, *Franchi* fails to disclose such a structure. Therefore, the reference fails to teach every element of claims 124 and 129, and the claims that depend therefrom, and Applicants request the withdrawal of the section 102 rejections of claims 124, 127, 129, 130, and 132.

Section 103 Rejections

Claims 126, 128, 131, 133, 135, 137, 140, and 142 were rejected under 35 U.S.C. § 103(a) as obvious over *Franchi*. To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), each of three requirements must be met. First the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. M.P.E.P. § 2143.03 (8th ed. 2001, Revised February 2003). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of

ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. *Id.* at § 2143.01. Third, a reasonable expectation of success must exist that the proposed modification will work for the intended purpose. *Id.* at § 2143.02. Moreover, each of these requirements must “be found in the prior art, and not be based on applicant’s disclosure.” *Id.* at § 2143.

Claims 126 and 128 depend from claim 124 and therefore indirectly recite a gaming terminal including means for receiving a game choice for a game from a player. As discussed above with regard to claim 124, *Franchi* fails to disclose such a structure. Furthermore, *Franchi* does not suggest means for receiving a game choice because each game computer in the reference monitors just one game. (*Franchi*, col. 5, ll. 13-14.) *Franchi* does not disclose an option for choice between games. Therefore, the reference fails to teach or suggest every element of claims 126 and 128, and Applicants request the withdrawal of the section 103 rejections of these claims.

Claims 131 and 133 depend from claim 129 and therefore indirectly recite a gaming terminal including means for receiving a game choice for a game from a player. As discussed above with regard to claim 129, *Franchi* fails to disclose such a structure. Furthermore, *Franchi* does not suggest means for receiving a game choice because each game computer in the reference monitors just one game. (*Franchi*, col. 5, ll. 13-14.) *Franchi* does not disclose an option for choice between games. Therefore, the reference fails to teach or suggest every element of claims 131 and 133, and Applicants request the withdrawal of the section 103 rejections of these claims.

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Claim 137 depends from claim 134, which recites a method including the step of receiving, at one of a plurality of game terminals, a game choice, and a wager amount for a game. As discussed above with reference to claim 134, *Franchi* fails to disclose such a method. Furthermore, *Franchi* does not suggest receiving a game choice because each game computer in the reference monitors just one game. (*Franchi*, col. 5, ll. 13-14.) No choice between games can be made. Therefore, the reference fails to teach or suggest every element of claim 137, and Applicants request the withdrawal of the section 103 rejection of the claim.

Claims 140 and 142 depend from claim 139 and depend from a claim reciting a method including the step of receiving, at one of a plurality of game terminals, a game choice, and a wager amount for a game, from a player. As discussed above with reference to claim 139, *Franchi* fails to disclose such a method. Furthermore, *Franchi* does not suggest receiving a game choice because each game computer in the reference monitors just one game. (*Franchi*, col. 5, ll. 13-14.) No choice between games can be made. Therefore, the reference fails to teach or suggest every element of claims 140 and 142, and Applicants request the withdrawal of the section 103 rejection of these claims.

Claims 120, 153, and 154 were rejected as obvious over *Hedges et al.* in view of *Franchi*. By this Amendment, Applicants have amended claims 120, 153, and 154 to distinctly claim aspects of the invention. Furthermore, claims 120, 153, and 154 depend from allowable claims for the reasons given above. Therefore, Applicants request the reconsideration and allowance of amended claims 120, 153, and 154.

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Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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